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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,330	07/23/2003	Takahiro Tanaka	2562/69798/JPW/FHB	7771

7590 03/22/2007
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/625,330

Applicant(s)

TANAKA, TAKAHIRO

Examiner

John m. Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1206</u> . | 6) <input type="checkbox"/> Other: _____ |

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Applicant's arguments filed 12-29-06 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Maruyama et al.(4,264,743).

Maruyama et al. disclose preparations of flexible open-celled polyurethanes having low-air permeability and being formed from feedstock including polyols, isocyanates, catalysts, foaming agents, oxyalkylene-siloxane foam stabilizers, and hydrocarbon fluid compounds which read on the processes and products claimed(see column 4 line 17 - column 8 line 36, column 5 line 50-59, column 9 lines 20-29, and column 16 lines 64-65, as well as, the examples, and the entire document). Maruyama et al. discloses ethylene oxide(EO)/propylene oxide(PO) and air permeability values meeting those of applicants' claims (see again, for example, column 7 lines 3-8, examples 1-6, and example 8, as well as, the entire document). Based on its disclosure of suitable operation over the full range of molecular weights values of applicants'

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claims (see column 6 lines 64-66, as well as, the full disclosure), it is held that Maruyama et al.'s disclosure readily envisions the molecular weight content values set forth by applicants' claims. Maruyama et al. is further not seen to be limited to the disclosure of its illustrative examples.

Maruyama et al.'s formed products appear to have consistency in permeability values throughout the samples they test. Since difference is not seen in the products realized, it is seen that the ranges of variation of air permeability values now recited in applicants' claims are inherent to the teaching of Maruyama et al.

The following previous arguments are maintained:

Applicants' arguments have been considered, but rejection is held to be proper for the reasons set forth above. Applicants' have not demonstrated association between the ranges of uniform, consistent, low-permeability values defined by the claims and the ranges of molecular weight values for the stabilizer component as defined by their claims, process limitations of their claims, and/or other compositional elements of their claims. Without such an association between the physical and process features of the claims and the ranges of qualitative values of the claims being demonstrated, examiner's position of inherency is not seen to fail.

As to the size of the blocks of Maruyama et al., the claims of the instant invention do not distinguish based on block size. However, Maruyama et al. does disclose the relevant thickness for testing of 10 mm thickness.

Maruyama et al.'s disclosure of other means of open-cell formation which may differ from the cell-opening operations of applicants' claims {note: issues raised under 35 USC 112 2nd paragraph above} in some of their embodiments does not derogate from the teachings of Maruyama et al. taken as a whole.

Applicants' latest arguments have been considered. However, rejection is maintained for all of the reasons set forth above.

The differences between the sample blocks run by applicants {Examples 1 and 2 from Table 2 of applicants' reply} and those of Maruyama et al. are noted. However, it is not seen that these samples adequately demonstrate that the products and processes of applicants' claims differ from the products and processes disclosed by Maruyama et al. If anything, the closeness in the "difference in air permeability values" of these samples {1.14 and 1.46 cc/cm²/sec, respectively} to the values of applicants' claims {less than 1 cc/cm²/sec } confirms the necessity that any showing attempting to exemplify the invention of Maruyama et al. must necessarily be as close to that which is actually disclosed by Maruyama et al. with any differences being necessarily explained. As to explanation of differences, it is additionally noted that applicants' reply does not explain the reasons for the differences between the samples discussed in their reply and those actually disclosed by Maruyama et al.

Finally, with regard to any evidence that may be presented in attempts to establish distinction between the products and processes of applicants' claims and the products and processes of Maruyama et al., it is not seen that showings or demonstrations of differences will be of much relevance in establishing distinction based on uniformity air permeability without difference being based on a clear standard of comparison set forth in the claims, such as, a specific block thickness and/or volume rather than the currently claim defined criteria of "throughout the entire body". As different shaped and/or cut articles are seen to be readily envisioned from the teachings of Maruyama et al., any showing of "difference in air permeability" at a subjectively and/or arbitrarily designed block thickness would be of little value in establishing

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distinction of the claimed products and processes of the instant claims over the products and processes of Maruyama et al. based on variation in air-permeability without clearly determinable and ascertainable basis for these values beings set forth in the claims.

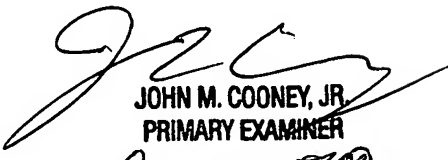
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700